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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/718,290

11/19/2003

Jeff Hooker

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EXAMINER

SHAN, APRIL YING

ART UNIT

PAPER NUMBER

2135

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/718,290

Applicant(s)

HOOKER ET AL.

Examiner

April Y. Shan

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 1-6 and 32-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 4/04 and 10/04.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

1. Claims 7-31 have been examined.

Election/Restrictions

2. Applicant's election without traverse of Group II (Claims 7-31) in the reply filed on 5 July 2007 is acknowledged.
3. The Applicant did not address in the response to election/restriction whether Group I (Claims 1-6) and Group III (Claims 32-38) are withdrawn or canceled. Thus, claims 1-6 and 32-38 are withdrawn from further consideration, as they are non-elected claims.

Priority

4. Applicant claimed that the current application claims priority to U.S. Provisional Application No. 60/427,568, entitled "IM Enterprise features," filed Nov. 20, 2002.

Examiner had reviewed carefully the U.S. Provisional Application (60/427,568). The U.S. Provisional application (60/427,568) only broadly discloses secure AIM. However, the examiner discovered at least three claim limitations, the secure message are signed and encrypted **using subscriber's digital certificates**, submitting a certificate publication request, the publication request also specifying a digital certificate corresponding to the subscriber device, responsive to each certificate publication request, the messaging server temporarily storing the submitted digital certificate in a publication record in the independent claim 1 of the current application are **not supported** by the U.S. Provisional application (60/427,568). Therefore, the examiner

will not grant the priority date as claimed. The effective filing date of the current application is the filing date of the current application, which is 19 November 2003.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 7-31 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 7-22 are directed to a method of managing the exchange of secure online instant message. The examiner respectfully asserts that the claimed subject matter does not fall within the statutory classes listed in 35 USC 101. The claimed steps do not result in a tangible result. Claims 7-22 are rejected as being directed to an abstract idea (i.e., producing non-tangible result) [tangible requirement does require that the claim must recite more than a 101 judicial exception, in that the process must set forth a practical application of that 101 judicial exception to produce a real-world result, Benson, 409 U.S. at 71-72, 175 USPQ at 676-77).

Claims 23-31 are directed to a messaging server for use in managing the exchange message. However, it appears that the device would reasonably be interpreted by one of ordinary skill in the art as software, per se. There is no element positively recited as part of the server. On par. [1066] of the original disclosure, the Applicant discloses "...such functionality is implemented as....software". It appears that such would reasonably be interpreted as representative of the software. As such, it is believed that the device of claims 23-31 is reasonably interpreted as functional

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descriptive material, per se. Further, storage is being recited in claim 23. The examiner carefully and respectfully reviews page 9 of the original disclosure, the Applicant discloses signal bearing media including analog or digital transmission media and analog.... Computer data signal and carrier wave are not limited to that which falls within a statutory category of invention because it is not limited to a process, machine, manufacture, or a composition of matter. Instead, it includes a form of energy. Energy does not fall within a statutory category since it is clearly not a series of steps or acts to constitute a process, not a mechanical device or combination of mechanical devices to constitute a machine, not a tangible physical article or object which is some form of matter to be a product and constitute a manufacture, and not a composition of two or more substances to constitute a composition of matter.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 7-9, 12, 15-17, 19, 23-25, 27-29 and 31 are rejected under 35

U.S.C. 102(e) as being anticipated by Schoen et al. (U.S. Pub. No. 20030204720).

As per **claims 7 and 23**, Schoen et al. discloses a method/messaging server of managing the exchange of secure online instant messages between subscriber devices, where the secure messages are signed and encrypted using subscribers' digital certificates ("PKI encrypted and/or signed IM packets" in fig. 1), the method comprising operations of:

- at one or more subscriber devices, an associated local instant messaging module logging in to a messaging server to begin a session of exchanging synchronous online messages (e.g. IM originator/recipient, IM Server in Fig. 1);

- at one or more of the logged-in devices, the associated local instant messaging module submitting a certificate publication request to a messaging server, the publication request also specifying a digital certificate corresponding to the subscriber device (e.g. par. [0074]);

- responsive to each certificate publication request, the messaging server temporarily storing the submitted digital certificate in a publication record in association with the submitting device as long as the associated instant messaging module remains logged-in to the messaging server (e.g. par. [0074]);

- responsive to prescribed events, the messaging server providing logged-in subscriber devices with selected information concerning certificates of other subscriber devices (e.g. par. [0074]).

As per **claims 8 and 24**, Schoen further discloses the operation of, responsive to prescribed events, providing logged-in subscriber devices with selected information concerning certificate status of other subscriber devices comprising: responsive to a request from one subscriber device to establish a dialog with another subscriber device, the messaging server providing the requesting subscriber device with a representation of a digital certificate of the other subscriber device from the publication record (e.g. par. [0074]).

As per **claims 9 and 25**, Schoen further discloses the operation of, responsive to prescribed events, providing logged-in subscriber devices with selected information concerning certificate status of other subscriber devices comprising: responsive to a particular subscriber device's request to publish a new digital certificate, the messaging server identifying other logged-in subscriber devices that have designated the particular subscriber device for potential future secured instant messaging, and providing the identified devices with a representation of the new digital certificate (e.g. par. [0074]).

As per **claims 12 and 27**, Schoen further discloses the operation of, responsive to prescribed events, providing logged-in subscriber devices with selected information concerning certificate status of other subscriber devices comprising: responsive to a request from a first subscriber device to establish a dialog with a second subscriber device, the messaging server denying supplication of the second

subscriber's digital certificate to the first subscriber whenever the second subscriber's digital certificate has experienced one or more of the following actions: invalidity, revocation, un-publication (e.g. par. [0073]).

As per **claims 15 and 28**, Schoen further discloses the operation of, responsive to prescribed events, providing logged-in subscriber devices with information concerning certificate status of other subscriber devices comprising: responsive to a particular subscriber device's published certificate becoming invalid, the messaging server identifying other logged-in subscriber devices that previously designated the particular subscriber device for potential future secured instant messaging, and notifying the identified devices of the invalid digital certificate (e.g. par. [0073]).

As per **claims 16 and 29**, Schoen further discloses the operation of temporarily storing the submitted digital certificate additionally storing a representation of a chain record pertaining to the certificate, where storage of repetitive chain records are abbreviated to conserve storage space (e.g. par. [0074]).

As per **claim 17**, Schoen further discloses the act of submitting the publication request is performed under one or more of the following conditions: (1) automatically in response to the act of logging in to the messaging server, (2) manually in response to operator direction (e.g. par. [0074]).

As per **claims 19 and 31**, Schoen further discloses where: the operations further comprise, responsive to each publication request, the messaging server receiving revocation information for the subscriber's certificate; upon expiration of the

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certificate as indicated by the revocation information, removing the subscriber's certificate from the publication record (e.g. par. [0073])

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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12. Claims 10-11, 13-14, 18, 26 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schoen et al. (U.S. Pub. No. 20030204720) as applied to claims 7-9, 12, 15-17, 19, 23-25, 27-29 and 31 above, and further in view of Perlman et al. (U.S. Patent No. 5,261,002)

As per **claims 10 and 26**, Schoen does not expressly disclosing receiving a particular subscriber device's request to un-publish its digital certificate; responsive to receiving the request, the messaging server removing the digital certificate from the publication record, identifying other logged-in subscriber devices that previously designated the particular subscriber device for potential future secured instant messaging, and notifying the identified devices of the digital certificate withdrawn from use.

Perlman et al. discloses receiving a particular subscriber device's request to un-publish its digital certificate; responsive to receiving the request, the messaging server removing the digital certificate from the publication record, identifying other logged-in subscriber devices that previously designated the particular subscriber device for potential future secured instant messaging, and notifying the identified devices of the digital certificate withdrawn from use (e.g. col. 7, lines 27-58).

It would have been obvious to a person with ordinary skill in the art to combine Perlman et al.'s receiving a particular subscriber device's request to un-publish its digital certificate; responsive to receiving the request, the messaging server removing the digital certificate from the publication record, identifying other logged-in subscriber devices that previously designated the particular subscriber device for

potential future secured instant messaging, and notifying the identified devices of the digital certificate withdrawn from use into Schoen et al. in order to avoid overhead and inconvenience associated with the use of authentication certificates as disclosed by Perlman et al. (e.g. col. 3, lines 56-61)

As per **claim 11**, Perlman et al. further discloses comprising: the particular subscriber device submitting the request to un-publish its digital certificate in response to at least one of the following events: (1) physical unavailability of the subscriber device's digital certificate, (2) logical unavailability of the subscriber device's corresponding digital certificate, (3) user election to un-publish the subscriber device's digital certificate (e.g. col. 7, lines 27-58).

As per **claim 13**, Perlman et al. further discloses comprising: delaying submittal of the certificate publication request under preventive circumstances including at least one of the following: (1) physical unavailability of the digital certificate, (2) logical unavailability of the digital certificate, (3) user election to delay publication of the digital certificate (e.g. col. 7, lines 27-58).

As per **claim 14**, Perlman et al. further discloses comprising: automatically submitting the certificate publication request when the preventive circumstances terminate (e.g. col. 7, lines 27-58).

As per **claims 18 and 30**, Perlman et al. further discloses comprising operations of: at one or more of the logged-in devices, an associated local instant messaging module submitting a certificate un-publication request to the messaging server

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responsive to specified conditions; responsive to each un-publication request, the messaging server removing the requesting subscriber's digital certificate from the publication record (e.g. col. 7, lines 27-58).

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (See PTO -892).

The Applicant is **strong urged** to review NPL programming Jabber by DJ Adams, Lord et al. (U.S. Patent 7,131,003) and Aravamudan et al. (U.S. Patent 6,301,609) in response to the current office action.

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Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to April Y. Shan whose telephone number is (571) 270-1014. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


17 September 2007
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